UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, Virginia 22313-1450
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/657,636	09/08/2003	Frank C. Nicholas	7710/10	2816

7590 09/18/2009

FRANK C. NICHOLAS
CARDINAL LAW GROUP
Suite 2000
1603 Orrington Avenue
Evanston, IL 60201

EXAMINER	
DURAN, ARTHUR D	
ART UNIT	PAPER NUMBER
3622	

MAIL DATE	DELIVERY MODE
09/18/2009	PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary	Application No.	Applicant(s)	
	10/657,636	NICHOLAS ET AL.	
	Examiner	Art Unit	
	Arthur Duran	3622	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE *3* MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on *08 September 2003*.

2a)☐ This action is **FINAL**. 2b)☒ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) *1-20* is/are pending in the application.

4a) Of the above claim(s) *7-20* is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) *1-6* is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☒ Claim(s) *7-20* are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☐ The drawing(s) filed on _____ is/are: a)☐ accepted or b)☐ objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a)☐ All b)☐ Some * c)☐ None of:

1.☐ Certified copies of the priority documents have been received.

2.☐ Certified copies of the priority documents have been received in Application No. _____.

3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1) ☒ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☒ Information Disclosure Statement(s) (PTO/SB/08) Paper No(s)/Mail Date *11/18/2005*.
4) ☐ Interview Summary (PTO-413) Paper No(s)/Mail Date. _____.
5) ☐ Notice of Informal Patent Application
6) ☐ Other: _____.

DETAILED ACTION

1. Claims 1-6 have been examined.

Election/Restrictions

2. Restriction to one of the following inventions is required under 35 U.S.C. 121:

I. Claims 1-6, drawn to geographic targeting related to websites, classified in 705/14.

II. Claims 7-13, drawn to generic and/or target ads, classified in class 705/14.

III. Claims 14-20, drawn to successive ad displaying, classified in 705/14.

Inventions I, II, and III are based on different sets of Independent claims. Group I involves geographic targeting related to websites. Group II involves generic and/or target ads. Group III successive ad displaying.

Because these inventions are independent or distinct for the reasons given above and there would be a serious burden on the examiner if restriction is not required because the inventions require a different field of search (see MPEP § 808.02), restriction for examination purposes as indicated is proper.

During a telephone conversation with Paul Holecko at (847)905-7107 at the Cardinal Law Group on 9/13/2007 a provisional election was made without traverse to prosecute the invention of Group I, claims 1-6. Affirmation of this election must be made by applicant in replying to this Office action. Claims 7-20 are withdrawn from further consideration by the examiner, 37 CFR 1.142(b), as being drawn to a non-elected invention.

Double Patenting

3. A rejection based on double patenting of the "same invention" type finds its support in the language of 35 U.S.C. 101 which states that "whoever invents or discovers any new and useful process ... may obtain a patent therefor ..." (Emphasis added). Thus, the term "same invention," in this context, means an invention drawn to identical subject matter. See *Miller v. Eagle Mfg. Co.*, 151 U.S. 186 (1894); *In re Ockert*, 245 F.2d 467, 114 USPQ 330 (CCPA 1957); and *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970).

A statutory type (35 U.S.C. 101) double patenting rejection can be overcome by canceling or amending the conflicting claims so they are no longer coextensive in scope. The filing of a terminal disclaimer cannot overcome a double patenting rejection based upon 35 U.S.C. 101.

Claims 1-6 provisionally rejected under 35 U.S.C. 101 as claiming the same invention as that of claims 1-6 of copending Application No.10/456,826. This is a provisional double patenting rejection since the conflicting claims have not in fact been patented.

Claim Rejections - 35 USC § 101

35 U.S.C. 101 reads as follows:

> Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

Claims 1-20 rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter. Based on Supreme Court precedent a method claim must (1) be tied to a particular machine or apparatus (see at least *Diamond v.* Diehr, 450 U.S. 175, 184 (1981); *Parker v.* Flook, 437 U.S. 584, 588 n.9 (1978); *Gottschalk v.* Benson, 409 U.S. 63, 70 (1972); *Cochrane v.* Deener, 94 U.S. 780, 787-88 (1876)) or (2) transform underlying subject matter (such as an article or materials) to

a different state or thing (see at least *Gottschalk v.* Benson, 409 U.S. 63, 71 (1972)). A method claim that fails to meet one of the above requirements is not in compliance with the statutory requirements of 35 U.S.C. 101 for patent eligible subject matter. To correct this issue, the independent claim could be amended such that at least one significant feature (not just data gathering or outputting) of the body of the claims actively uses a technological apparatus (computer, server, processor, etc).

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

> A person shall be entitled to a patent unless –
>
> (a) the invention was known or used by others in this country, or patented or described in a printed publication in this or a foreign country, before the invention thereof by the applicant for a patent.

4. Claims 1, 2, 5, 6 are rejected under 35 U.S.C. 102(a) as being anticipated by Holtz (2002/0053078).

Claim 1: Holtz discloses a method of online advertising comprising:

Receiving at least one generic ad request for a generic advertiser (Fig. 2, 'National Ad Server', 'National Advertising Management Distribution Server'; [303]);

Providing geo-target availability based on a number of requested impressions for the generic ad request and a web site designation for the generic ad request ([303, 305]; Abstract, "An advertisement reporting system monitors the sale and distribution of advertisements within the network. The advertisements are priced according to factors that measure the likelihood of an advertisement actually being presented or viewed by users most likely to purchase the

advertised item or service. The advertisement reporting system also collects metrics to invoice and apportion income derived from the advertisements among the network participants, including a portal host and/or producer of the content. ");

Receiving geographically targeted ad requests including target information from one or more child advertisers at an ad server node (Figure 2, 'City A', 'City B', 'Local Ad Server'; [303]);

Determining a media buy output based on the received geographically targeted ad requests and the generic ad request (Figure 14, 'Reporter', [77, 78, 303]).

Claim 2: Holtz discloses the method of claim 1 wherein the geo-target availability is based on historical statistical data (claim 4).

Claim 5: Holtz discloses the method of claim 1 wherein the ad server node is a targeted ad wrapper system ([239]). Note that the Applicant's Specificaiton defines a targeted ad wrapper system to have a default advertisement.

Claim 6: Holtz discloses the method of claim 1 wherein the target information comprises information selected from the group consisting of: time, demographics, geography, area of influence, and a combination thereof ([236]).

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

5. Claims 3, 4 is rejected under 35 U.S.C. 103(a) as being unpatentable over Holtz (2002/0053078) in view of Armstrong (2002/0087352).

Holtz discloses the above. Holtz further discloses local and national advertisers. Holtz does not explicitly disclose franchisers or political groups.

However, Armstrong discloses a local franchisee of a national franchiser ([5,48,55]). Therefore, it would have been obvious to one having ordinary skill in the art at the time the invention was made that Holtz's national and local advertisers can be national and local franchises or organizations such as political groups. One would have been motivated to do this in order to better match Holtz's system for national/local businesses and advertisers with the situation that many business and advertisers are franchises.

Conclusion

The following prior art made of record and not relied upon is considered pertinent to applicant's disclosure:

a) Ranka (2007/0050204) discloses optimizing ad allocation based on an iterative analysis of ad performance on parameters including geographic parameters.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Arthur Duran whose telephone number is (571) 272-6718. The examiner can normally be reached on Mon- Fri, 8:00-4:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Eric Stamber can be reached on (571) 272-6724. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see http://pair-direct.uspto.gov. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

Arthur Duran
Primary Examiner
Art Unit 3622

/Arthur Duran/
Primary Examiner, Art Unit 3622
6/15/09